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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,770	04/11/2001	Carlos De La Hurga	250591.90279	2242

7590 07/20/2004  
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EXAMINER

MISKA, VIT W

ART UNIT PAPER NUMBER

2841

DATE MAILED: 07/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/832,770

Applicant(s)

DE LA HUERGA, CARLOS

Examiner

Vit W. Miska

Art Unit

2841

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/20/03, 3/30/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-153 is/are pending in the application.
- 4a) Of the above claim(s) 12-14, 16, 18-21, 30-32, 34, 35, 37-106 and 109-153 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15, 17, 22-29, 33, 36, 107 and 108 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2,3,5,6,7,8,10</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicant's election with traverse of one of the species of Figs. 59-63 in the reply filed on 10/28/2003 and supplemental reply of 3/30/2004 is acknowledged. Applicant elected the embodiment described at paragraphs 0411-0428 that provides an alarming function when medication is to be taken.

The traversal is on the ground(s) that several of the claims are generic to many of the species. This is not found persuasive because, although applicant's argument may be true, 37CFR1.146 permits restriction to a single species if no generic claim is held allowable and MPEP808.01(a) requires election of species in applications containing species and generic claims.

The requirement is still deemed proper and is therefore made FINAL.

2. Applicant's statement of the claims readable on the elected species is not considered accurate. Applicant elected the alarming feature in combination with the system described in paragraphs 0411-0428. Applicant was informed in the previous letter of 2/26/2004 that several embodiments or species are suggested in these paragraphs. Thus, for purposes of this election, the elected species is considered as system 1300 including several of the containers shown in Fig. 59, sensor pad 1370 with RFID sensors (par. 0419), a separate interface 1310 (par. 0414) connected to pad

1370 via cable 1580, an alarm indicator 132 of interface 1310 for providing an indication that medication is to be consumed. Several of the suggested variations preceded by the term "may include" in these description paragraphs not noted above are considered separate non – elected species.

Therefore, the claims considered readable on the elected species are: 1-11, 15, 17, 22-29, 33, 36 and 107-108.

The remaining claims are considered not readable on the elected species for the following reasons (claims 13, 16, 30-31, 40, 42, 57-59 and 66 have been indicated by applicant as directed to the non-elected species):

Claims 12-14 include "a portable device" or "console" as containing processor (interface 1310) and sensor, which are shown as separate in Fig. 59.

Claims 18, 32, 34, 35 require a communication device (alarm for indicating time to take medication) attached to each of the containers, whereas elected species has alarm 132 attached to interface 1310.

Claims 19-21 require indicating when medication is consumed at a non-optimum time, a feature not described in the paragraphs noted above.

Claims 37-39, 43-81, 100-106, 110-126, 140 require a consumption indicator for obtaining consumption time information when medication is consumed by the user, not described in connection with the elected species.

Claim 40 requires a remote server processor linked to the sensor via a computer network, described as alternative embodiment at par. 0414,

Claims 41-42, 109 require a serial number identification, described as a separate embodiment at par. 0427.

Claims 82-84 require the health safety function as determining if the user is allergic to the medication, not described in the appropriate paragraphs.

Claims 85-87, 130-132 require storing prescription record for several users and organizing the information for each container according to the user, not described in the selected paragraphs.

Claims 88-93, 133-135 require determining the prudence of the user consuming each of two medications and storing contraindication information, not described in the relevant paragraphs.

Claims 94-99, 136-139 require accessing a database for retrieving messages, not described in the selected paragraphs or directed to a different embodiment.

Claims 127-129, 146 requires if the user is allergic to the medication, not described in the paragraphs directed to the elected species..

Claims 141-142, 151 require identifying relative consumption times as a function of both first and second container specifying information, this embodiment not described in the selected description paragraphs.

Claims 143-145 require determining when a refill should be ordered, not described in the relevant paragraphs.

Claims 147-150 require comparing a sub-set of information and the specifying information, this feature not described in the relevant paragraphs.

Claims 152-153 require providing portions of the medication regimens corresponding to a remote consumption period to a remote device and storing the regimens on the remote device, not described in pars. 041-0428.

3. Claims 12-14,6,18-21,30-32,34,35,37-106 and 109-153 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/28/2003.

### ***Claim Objections***

4. Claims 3-10 objected to because of the following informalities: Claim 3 recites the limitation "the antenna" in line 2. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

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by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-11 15, 17, 22-29, 33, 36 and 107-108 are rejected under 35 U.S.C. 102(e) as being anticipated by Yarin et al. The reference discloses a medication system for performing health safety functions including containers 34 for holding doses of medication, the containers having RF memory device 50 containing specifying information useable to determine a prescribed dosing regimen for the medication (see col. 7, lines 39ff and col. 9, lines 7ff), RF sensors 41 (antennae) defining sensing areas 36 for receiving the specifying information, processor 40 receiving the specifying information to identify a prescribed dosing regimen (col. 9, lines 7-20), communication device 36 or 36' (Fig. 13), timing device inherently associated with processor 40 (see also col. 10, line 60) and necessary to produce the time alerts for the medication, the processor causing the communication means 36 to indicate predetermined times, col. 10, line 66, horizontal sensor surface 30, container 34 with downward surface 34a and

RF tag 50 attached thereto, aligners 32 for distinguishing sensing and non-sensing sections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vit W. Miska whose telephone number is 571-272-2108. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Martin can be reached on 571-272-2107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VM  
6/24/2004



Vit Miska  
Primary Examiner